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Remarks:

Regarding the rejection of claims 1-6, 11, 12, 14 and 17-19 under 35 USC 102(b) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin, and its withdrawal is respectfully requested.

Regarding the rejection of claims 9 and 20 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin"):

The applicant's amendment to claim 1, of which claim 9 is dependent, is believed to render the instant grounds of rejection lodged against claim 9 as moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin, and its withdrawal is respectfully requested.

The applicant traverses the Examiner's rejection of claim 20, as that claim has now been canceled, and its subject matter incorporated into claim 1. However as claim 1 presumably now would be rejected, the applicant addresses the presumed rejection of claim 1 as currently presented.

Prior to discussing the merits of the Examiner's position, the undersigned reminds the Examiner that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). There must be some suggestion, teaching, or motivation arising from what the prior art would have taught a person of ordinary skill in the field of the invention to make the proposed changes to the reference.

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In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). But see also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The applicant asserts that the currently claimed invention would not be obvious from the DeGueterchin reference.

As the Examiner admits, DeGueterchin fails to teach "the self-induced motility" of the DeGueterchin three component system in equilibrium and that DeGueterchin fails to positively state such a property. The applicant point out that with respect to his systems, DeGueterchin states at columns 11 and 12 the following:

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The variations in formulas of compositions within the invention which are in the tricritical or near tricritical state are easily ascertainable, and the invention is readily understood when reference is made to this specification, including the working examples thereof, taken in conjunction with the phase diagrams. 20

In the previous description of the components of the invented compositions and proportions thereof which may be operative, boundaries were drawn for preferred compositions within the invention, but it will be evident that one seeking to manufacture the invented near tricritical point compositions will select proportions of components indicated by the phase diagrams for the particular compositions, so that the desired compositions will be within the near tricritical area. Similarly, the tricritical point compositions selected should be such that upon contact with water, the lipophilic soil will be removed from a substrate. 25 30

For plotting of the phase diagrams and in experiments undertaken by the inventors to establish the formulas of the desired tricritical point compositions, many different compositions within the invention were made and were characterized. 35

To make the near tricritical point compositions of the invention is relatively simple because they tend to form spontaneously with little need for the addition of energy to promote transformation of the tricritical state. However, to promote uniformity of the composition, mixing will normally be undertaken and it has been found desirable, but not compulsory, to first mix the amphiphile and water together, followed by admixing of the non-polar solvent or weakly 40 45

solvent component. It is not usually necessary to employ heat and most mixings are preferably carried out at about 20-25° C. or higher.

As is evident from the foregoing, DeGueterchin notes that such compositions are readily made: "... is readily simple because they tend to form spontaneously with little need for the addition of energy to promote transformation of the tricritical state". Thus, it is believed to be quite clear that DeGueterchin teaches and is solely directed to his compositions which exist, in equilibrium, at the tricritical point, and clearly DeGueterchin discusses methods for the production of such compositions. But, DeGueterchin fails to disclose any allied technical effect such as would provide a "visual

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indicator” to a consumer or user of such a composition, such as only the present applicants teach in their specification, e.g., a “Marangoni effect” or “self-induced motility” when dispensed or utilized. While the Examiner asserts that “the claimed effects and physical properties [...] would be implicitly achieved by a composition with all the claimed ingredients, the applicant strongly disagrees. Notwithstanding the Examiner’s later assertion that “evidence would need to be presented”, the applicants respectfully traverse this requirement, and assert that as DeGueterchin is wholly silent as to any visual effect, the Examiner’s position is one of a impermissible “hindsight reconstruction”, using applicant’s claim as a template to reconstruct the invention by picking and choosing amongst isolated portions of the several prior art documents in an attempt to construct the applicant’s presently claimed invention by picking and choosing amongst isolated disclosures from the prior art. This is impermissible under the law. For example, in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), the Federal Circuit stated:

“It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600)

Such is however, proscribed. Reconsideration of such a requirement and its withdrawal is solicited. The applicant also traverses the Examiner’s later requirement that the application contains “inadequate disclosure”; the Examiner’s attention is respectfully directed to the applicant’s specification as a whole, and in specific to the following passages:

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[0006] The composition may be in the form of a single phase or it may be present as two or three phases in mutual chemical equilibrium. Where the composition is a single phase, it has the advantage that it does not need to be mixed or shaken prior to use. Where the composition is in the form of 2 or 3 phases, the visual cleaning indication due to motility of the system is more visible. Preferably the composition is adjacent to a phase boundary on the three-component phase diagram for the composition. By this it is meant that a change in relative weight percentages of the three components of the composition caused by loss of only one component, whereby the weight percentage of that component is reduced by an absolute value of 1% or less, preferably 0.5% or less, more preferably 0.1% or less (expressed as percentage by weight of the total weight of the total composition), leads to a change in the number of phases present in the composition, for instance changing from a single phase to a 2 or 3 phase mixture.

[0047] Remarkably, we have found that compositions of the invention may apparently exhibit behaviour of the Marangoni type. When a jar of a preferred composition of the invention is opened and exposed to the environment the surface may be seen to "twitch". This effect is believed to be due to surface tension gradients, perhaps allied to crossing of phase boundaries, when volatile compounds evaporate. We have observed such compositions in which, when the lid is replaced on the jar, the "twitching" stops. The "twitching" may be if the composition is pipetted onto a surface.

[0048] By "twitching" we mean that the surface of the composition exhibited motility not induced by an external agent, such as an object applied to it; in other words a self-induced motility.

as well as the representative Examples of the invention, as well as Figs. 1 and 2. The applicant asserts that following selection of an amphiphile and a volatile hydrocarbon, especially from those recited by the applicant, a ternary diagram of the phase boundaries may be generated and in accordance with the guidelines of para [0006], inventive formulations may be produced without undue experimentation which will satisfy the requirements of para. [0047]. The foregoing teachings from the applicant's specification are believed to sufficiently enable the scope of applicant's invention. The Examiner is reminded that "... the enablement requirement is met if the description enables any mode of making and using the invention." *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1361 [47 USPQ2d 1705] (Fed. Cir. 1998); see also: *Amgen Inc. v. Hoechst Marion*

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Roussel, Inc., 314 F.3d 1313, 1335 [65 USPQ2d 1385] (Fed. Cir. 2003); *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1533 [20 USPQ2d 1300] (Fed. Cir. 1991)

Regarding the rejection of claim 10 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot, particularly in view of the remarks entered above regarding the rejection of prior claim 20, now incorporated into claim 1. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin, and its withdrawal is respectfully requested.

Regarding the rejection of claims 7 and 8 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin") further in view of US 5646105 to Hachmann (hereinafter simply "Hachmann"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin and Hachmann, and its withdrawal is respectfully requested.

Regarding the rejection of claim 13 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin") further in view of US 5499486 to Iaia (hereinafter simply "Iaia"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin and Iaia, and its withdrawal is respectfully requested.

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Regarding the rejection of claim 13 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin") further in view of US 5499486 to Iaia (hereinafter simply "Iaia"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin and Iaia, and its withdrawal is respectfully requested.

Regarding the rejection of claim 15 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin") further in view of US 5624906 to Vermeer (hereinafter simply "Vermeer"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin and Vermeer, and its withdrawal is respectfully requested.

Regarding the rejection of claim 16 under 35 USC 103(a) in view of US 5527486 to DeGuertechin (hereinafter simply "DeGueterchin") further in view of US 5__041 to Johansson (hereinafter simply "Johannson"):

The applicant's amendments to the claims are believed to render the instant grounds of rejection moot. Accordingly, reconsideration of the propriety of the rejection in view of DeGueterchin and Johansson, and its withdrawal is respectfully requested.

In view of the foregoing amendments to the specification and the claims and further in view of the foregoing remarks, reconsideration of the rejections raised by the Examiner against the currently presented claims is respectfully requested. Should the Examiner in charge of this application believe that telephonic communication with the undersigned representative would meaningfully advance the prosecution of this application towards allowance, the Examiner is invited to contact the undersigned at their convenience.

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PETITION FOR A ONE-MONTH EXTENSION OF TIME

The applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;



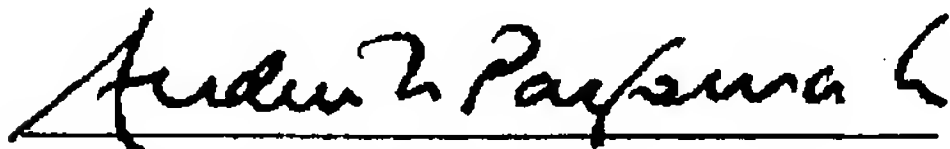
Andrew N. Parfomak, Esq.
Reg.No. 32,431
Norris, McLaughlin & Marcus, PC
875 Third Avenue, 18th Floor
New York, NY 10022

23 Nov. 2008
Date:

Tel: 212 808-0700

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Andrew N. Parfomak

23 November 2008
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